

Petition to Vacate Finality of Office Action

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: April 13, 2009 Signature: _____

(Carol Martin)

Docket No.: 68144/P020US.B/10505125
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Palaniappan Meiyappan

Application No.: 10/534,200

Confirmation No.: 5266

Filed: January 18, 2006

Art Unit: 2617

For: METHOD AND APPARATUS FOR
ADAPTIVE CARRIER ALLOCATION AND
POWER CONTROL IN MULTI-CARRIER
COMMUNICATION SYSTEMS

Examiner: S. T. Zewari

PETITION TO VACATE FINALITY OF OFFICE ACTION
UNDER 37 C.F.R. § 1.181

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Petitioner respectfully requests to have the finality of the Final Office Action dated March 3, 2009 (hereinafter "Final Action") vacated as premature under 37 C.F.R. § 1.181. The finality of the Final Action is improper because it has introduced new grounds of rejection that were not necessitated by any amendments to the claims, nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 C.F.R. 1.97(c). See M.P.E.P. § 706.07(a).

STATEMENT OF FACTS

In a non-final Office Action dated January 22, 2008 (hereinafter "Non-final Action"), the Examiner raised certain grounds of rejection for the claims. In response, Petitioner filed a

response on December 9, 2008 (hereinafter “Response to Non-final Action”), traversing the grounds of rejection raised in the Non-Final Action. Petitioner did not amend the claims in its response to the Non-final Action. Thereafter, the Examiner mailed the Final Action, dated March 13, 2009.

Petitioner respectfully submits that the Examiner modified the grounds of rejection in the Final Action such that new grounds of rejection were relied upon, and thus the rejections in the Final Action are improper pursuant to M.P.E.P. § 706.07(a).

During an Examiner Interview conducted on March 31, 2009, Petitioner informed the Examiner of Petitioner’s belief that the finality of the Final Action was improper and requested that the Examiner withdraw such finality. The Examiner did not agree to do so. In an effort to advance prosecution, Petitioner submits this petition requesting the Director to vacate the finality of the Final Action for the reasons discussed further below.

POINTS TO BE REVIEWED

I. Improper New Grounds of Rejection

As Petitioner best understands from the Interview, the Examiner asserted that he did not present new grounds of rejection; instead, he was merely “responding” to Petitioner’s arguments. As such, according to the Examiner, the new rejections are “supplemental” but do not constitute “new” rejections. However, this assertion is incorrect because placing new rejections under a different heading, e.g., “Response to Amendment,” does not change the fact that the Examiner has set forth additional arguments, new reasons, and new rationale (e.g., inherency and official notice) for rejecting the claims. These new rejections are now part of the prosecution record, and if Petitioner elects to appeal the Final Action, Petitioner will be required to address these newly raised grounds set forth by the Examiner. As such, simply characterizing the new rejections as a “response” does not and cannot change the nature of the rejections, and it does not change the fact that the new rejections impose additional burden to address the Examiner’s assertions that Petitioner will be required to satisfy.

A. Inherency

“In relying upon the theory of inherency, the Examiner must provide a basis in

fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); M.P.E.P. § 2112. As such, in addition to presenting inherency as a new ground of rejection in the Final Action, the Examiner failed to comply with the requirements for raising an inherency rejection.

Claim 1: “determining a location”

Claim 1 recites “determining a location of a subscriber with respect to a base station.” In the Non-final Action, the Examiner initially contended that *Huang* teaches such limitation and cited to *Huang*’s figure 1 (selector 18), col. 4 lines 52-53, figure 2 (steps 18, 22, and 24), and col. 6 lines 10-15. *See* Non-final Action, page 5. In response, Petitioner argued that *Huang* does not disclose this limitation because *Huang* is only concerned with the load level on its carriers and not the location of its subscribers.

In the Final Action, the Examiner modified his rejection to rely, for the first time, upon an alleged “inherent” tracking of subscribers by communication systems as teaching this limitation of claim 1. For instance, the Examiner stated in the Final Action that Petitioner’s arguments were not persuasive because “the communication systems inherently track the locations of the subscribers within the network.” *See* Final Action, page 2. Petitioner notes that the Examiner made no mention whatsoever of any alleged “inherent tracking” in the Non-Final Action, but instead clearly relied upon only *Huang* as disclosing the recited limitation. The “inherent tracking” is alleged for the first time in the Final Action as a new grounds for rejecting the recited “determining a location of a subscriber,” and as the sole basis that the Petitioner’s arguments were not persuasive. The Examiner did not clarify whether he was referring specifically to *Huang*’s communication systems or generally to all communication systems. Even if the Examiner was referring to *Huang*’s communication system, the finality is still improper because if no amendments are made to the claims, reliance on other teachings in the reference for rejecting the claims should not be made final. *See e.g.*, M.P.E.P. § 2144.03(D). Moreover, the Examiner has raised an inherency rejection, which is a new ground of rejection. As such, the Examiner appears to have relied either upon personal knowledge regarding the state of the art at the time of the invention or upon other non-cited portions of *Huang* or some other reference that

the Examiner failed to clearly identify in the rejection.

Because prosecution of the application is now closed, Petitioner was not afforded a full and fair opportunity to respond to the Examiner's assertion of personal knowledge by e.g., requesting an affidavit from the Examiner or a reference that supports the Examiner's assertion that "communication systems inherently track the locations of the subscribers within the network." By making the new grounds of rejection final, Petitioner has been prematurely foreclosed from fully addressing the new grounds of rejection that were raised for the first time in the Final Action. "It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." M.P.E.P. §706.02(j). Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for at least the above reason.

Claims 1, 17, and 19: "indicating to the subscriber"

Claim 1 recites "indicating to the subscriber whether or not to adjust transmit power to above its normal transmit power range." Claims 17 and 19 recite a similar limitation. In the Non-final Action, the Examiner cited *Huang*'s figure 1 (load measurer 14), col. 4 lines 3-7, lines 13-19 as satisfying this limitation. *See* Non-final Action, page 5. In response, Petitioner argued that the Examiner pointed to *Huang*'s load measurer, which simply measures the load of each carrier and is not capable of communicating with the subscriber to indicate to the subscriber whether or not to transmit power.

In the Final Action, although the Examiner reiterated that "*Huang* discloses measuring uplink/downlink power" (*see* Final Action, pages 3 and 5), he modified his rejection to rely, for the first time, upon an alleged "inherent" measuring of transmission/reception power as teaching this limitation of claim 1. That is, the Examiner stated that "[i]t is an inherent part of the communication system to measure transmission/reception power (emphasis added)." *See* Final Action, page 3. Thus, rather than maintaining that *Huang* teaches the recited limitation, the Examiner now applies a different ground of rejection.

Petitioner notes that the Examiner made no mention whatsoever of any alleged "inherent measuring" in the Non-Final Action, which is now being asserted for the first time in the Final

Action as a new grounds for rejecting the recited “indicating to a subscriber.” The Examiner offers no support for his conclusion that it is an inherent part of the communication system to measure transmission/reception power.

The change in the grounds of rejection relied-upon in the Final Action was not necessitated in any way by an amendment or an IDS presented by Petitioner, but is instead presented in response to Petitioner’s successful traversal of the Examiner’s initial grounds of rejection presented in the Non-Final Action. Thus, the Final Action was improperly made final. Further, Petitioner has not been afforded a full and fair opportunity to consider and respond to the new grounds of rejection because the new grounds were explained for the first time in the Final Action. Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

Claim 22: “comparing interference”

Claim 22 recites “comparing interference to adjacent channel leakage power with output power of a subscriber.” In the Non-final Action, the Examiner pointed to *Huang*’s abstract, figure 2, column 5 lines 57-67, and column 6 lines 6-17 as teaching this limitation. In response, Petitioner argued that the cited portions do not explicitly disclose this limitation.

In the Final Action, the Examiner modified his rejection to rely, for the first time, upon an alleged “inherent” comparison in *Huang*, stating that *Huang* discloses “selecting a carrier from amongst carriers and this inherently involves comparison (emphasis added).” See Final Action, page 3. Thus, rather than maintaining that *Huang* teaches the recited limitation, the Examiner now applies a different ground of rejection.

Petitioner notes that the Examiner made no mention whatsoever of any alleged “inherent comparison” in the Non-Final Action, which is now being asserted for the first time in the Final Action as a new grounds. The Examiner offers no support for his conclusion that selecting a carrier from amongst carriers inherently involves comparison, let alone comparing interference to adjacent channel leakage power with output power of a subscriber, as recited by claim 22.

The change in the grounds of rejection relied-upon in the Final Action was not necessitated in any way by an amendment or an IDS presented by Petitioner, but is instead

presented in response to Petitioner's successful traversal of the Examiner's initial grounds of rejection presented in the Non-Final Action. Thus, the Final Action was improperly made final. Further, Petitioner has not been afforded a full and fair opportunity to consider and respond to the new grounds of rejection because the new grounds were explained for the first time in the Final Action. Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

B. Official Notice/Well Known in the Art/Personal Knowledge

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known (emphasis added.)" M.P.E.P. § 2144.03. As such, in addition to presenting well-known art as a new ground of rejection in the Final Action, the Examiner failed comply with the requirements for taking an Official Notice, as the allegedly well-known art is not "capable of instant and unquestionable demonstration of being well-known."

Claims 1 and 18: "selecting . . . according to the location of the subscriber"

Claim 1 recites "selecting carriers from a band of multi-carriers to allocate to the subscriber according to the location of the subscriber with respect to the base station." Claim 18 recites a similar limitation. In the Non-final Action, the Examiner cited *Huang*'s figures 1 (selector 18) and 2 (steps 18, 22, and 24), column 4 lines 52-53, and column 6, lines 10-15 as teaching this limitation. In response, Petitioner argued that *Huang* selects the carrier based on the load level and not "according to the location of the subscriber with respect to the base station," as recited by the claims.

In the Final Action, the Examiner modified his rejection to rely, for the first time, upon his personal knowledge. Although the Examiner referred back to *Huang* as teaching selecting a carrier to prevent or permit hand off, the Examiner raised new grounds by stating that the "hand off, among other things, depends on location of subscriber," without citing to a specific section in *Huang* or any other references. See Final Action, pages 2-3. As such, the Examiner appears to be relying on his personal knowledge regarding the state of the art at the time of the invention

or upon other non-cited portions of *Huang* or some other reference that the Examiner failed to clearly identify in the rejection. Even if the Examiner relied on *Huang* for his assertion, the finality is still improper because if no amendments are made to the claims, reliance on other teachings in the reference for rejecting the claims should not be made final. *See e.g.*, M.P.E.P. § 2144.03(D).

Petitioner notes that the Examiner made no mention whatsoever that “hand off . . . depends on location of subscriber” in the Non-Final Action, which is now being asserted for the first time in the Final Action as a new ground. The Examiner offers no support for his conclusion that hand off depends on subscriber’s location. Thus, rather than maintaining previous grounds for rejection, the Examiner now applies a different ground of rejection.

The change in the grounds of rejection relied-upon in the Final Action was not necessitated in any way by an amendment or an IDS presented by Petitioner, but is instead presented in response to Petitioner’s successful traversal of the Examiner’s initial grounds of rejection presented in the Non-Final Action. Thus, the Final Action was improperly made final. Further, Petitioner has not been afforded a full and fair opportunity to consider and respond to the new grounds of rejection or the Examiner’s personal knowledge because the new grounds were explained for the first time in the Final Action. Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

Claim 3:

Claim 3 recites “selecting carriers closer to or at the center of the band when the subscriber is far away from the base station; and selecting carriers farther away from the center of the band when the subscriber is close to the base station.” In the Non-final Action, the Examiner cited *Hess*’ figure 8, column 3 lines 58-65, and column 9 lines 34-49 as teaching his limitation. In response. Petitioner argued that *Hess* assigns channels based upon the signal strength received by the base station, and *Hess* does not explicitly disclose that this received signal strength correlates to a subscriber’s location.

In the Final Action, Examiner modified his rejection to rely, for the first time, upon his personal knowledge. The Examiner asserted that “received signal strength is an indicator of the

location of the subscriber,” without citing to a specific section in *Hess* or any other references. See Final Action, page 5. As such, the Examiner appears to be relying on his personal knowledge regarding the state of the art at the time of the invention or upon other non-cited portions of *Hess* or some other reference that the Examiner failed to clearly identify in the rejection. Even if the Examiner relied on *Hess* for his assertion, the finality is still improper because if no amendments are made to the claims, reliance on other teachings in the reference for rejecting the claims should not be made final. See *e.g.*, M.P.E.P. § 2144.03(D).

Petitioner notes that the Examiner made no mention whatsoever that “received signal strength is an indicator” of a subscriber’s location in the Non-Final Action, which is now being asserted for the first time in the Final Action as a new ground. The Examiner offers no support for this conclusion. Thus, rather than maintaining previous grounds for rejection, the Examiner now applies a different ground of rejection.

The change in the grounds of rejection relied-upon in the Final Action was not necessitated in any way by an amendment or an IDS presented by Petitioner, but is instead presented in response to Petitioner’s successful traversal of the Examiner’s initial grounds of rejection presented in the Non-Final Action. Thus, the Final Action was improperly made final. Further, Petitioner has not been afforded a full and fair opportunity to consider and respond to the new grounds of rejection or the Examiner’s personal knowledge because the new grounds were explained for the first time in the Final Action. Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

Claim 4: “calculating a time delay”

Claim 4 recites “calculating a time delay and a path loss associated with the subscriber.” In the Non-final Action, the Examiner pointed to *Huang*’s col. 1 lines 55-67 as teaching this limitation. In response, Petitioner argued that the cited portion merely mentions a time out but does not explicitly teach such calculation.

In the Final Action, the Examiner modified his rejection to rely, for the first time, upon his personal knowledge. Although the Examiner referred back to *Huang* as teaching a time out, the Examiner raised new grounds by stating that the time out is “calculating delay of the

response,” without citing to a specific section in *Huang* or any other references. *See* Final Action, page 4. As such, the Examiner appears to be relying on his personal knowledge regarding the state of the art at the time of the invention or upon other non-cited portions of *Huang* or some other reference that the Examiner failed to clearly identify in the rejection. Even if the Examiner relied on *Huang* for his assertion, the finality is still improper because if no amendments are made to the claims, reliance on other teachings in the reference for rejecting the claims should not be made final. *See e.g.*, M.P.E.P. § 2144.03(D).

Petitioner notes that the Examiner made no mention whatsoever that “a time out . . . is calculating delay of the response” in the Non-Final Action, which is now being asserted for the first time in the Final Action as a new ground. The Examiner offers no support for his conclusion that *Huang*’s time out is calculating delay of the response. Thus, rather than maintaining previous grounds for rejection, the Examiner now applies a different ground of rejection.

The change in the grounds of rejection relied-upon in the Final Action was not necessitated in any way by an amendment or an IDS presented by Petitioner, but is instead presented in response to Petitioner’s successful traversal of the Examiner’s initial grounds of rejection presented in the Non-Final Action. Thus, the Final Action was improperly made final. Further, Petitioner has not been afforded a full and fair opportunity to consider and respond to the new grounds of rejection or the Examiner’s personal knowledge because the new grounds were explained for the first time in the Final Action. Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

Claim 7: “adjusting a power control setting.”

Claim 7 recites “adjusting a power control setting for the subscriber at the base station.” In the Non-final Action, the Examiner cited *Huang*’s column 7 lines 64-67 as teaching this limitation. In response, Petitioner argued that *Huang* is changing the threshold of interference programmed at the base station but not “adjusting a power control setting,” as recited by claim 7.

In the Final Action, Examiner modified his rejection to rely, for the first time, upon “adjusting power level in a mobile subscriber” as “well known in the art (emphasis added).” *See*

Final Action, page 4. As such, the Examiner is clearly relying on a new ground of rejection by relying on “well known” prior art pursuant to M.P.E.P. § 2144.03.

Petitioner notes that the Examiner made no Official Notice whatsoever that “adjusting power level in a mobile subscriber” is well known in the art in the Non-Final Action, which is now being asserted for the first time in the Final Action as a new ground. The Examiner offers no support for his assertion of this alleged common knowledge. Thus, rather than maintaining that *Huang* teaches the recited limitation, the Examiner now applies a different ground of rejection.

The change in the grounds of rejection relied-upon in the Final Action was not necessitated in any way by an amendment or an IDS presented by Petitioner, but is instead presented in response to Petitioner’s successful traversal of the Examiner’s initial grounds of rejection presented in the Non-Final Action. Thus, the Final Action was improperly made final. Further, Petitioner has not been afforded a full and fair opportunity to consider and respond to the new grounds of rejection because the new grounds were explained for the first time in the Final Action. Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

Claim 12:

Claim 12 recites “wherein the carrier allocator allocates carriers at edges of a band to the nearest subscribers.” In the Non-final Action, the Examiner relied on *Huang*’s Figure 7 and column 10 lines 59-61 as teaching this limitation. In response, Petitioner argued that the cited portion simply discusses allocation of carriers in general and not specifically allocation of carriers at edges of a band to the nearest subscribers.

In the Final Action, Examiner modified his rejection to rely, for the first time, upon his personal knowledge. Although the Examiner referred back to *Huang* as disclosing allocating a carrier, the Examiner raised new grounds by stating that “*Huang*’s system [has] all the structural elements to allocate carriers at any part of the band,” without citing to a specific section in *Huang* or any other references. See Final Action, page 4. As such, the Examiner appears to be relying on his personal knowledge regarding the state of the art at the time of the invention or

upon other non-cited portions of *Huang* or some other reference that the Examiner failed to clearly identify in the rejection. Even if the Examiner relied on *Huang* for his assertion, the finality is still improper because if no amendments are made to the claims, reliance on other teachings in the reference for rejecting the claims should not be made final. *See e.g.*, M.P.E.P. § 2144.03(D).

Petitioner notes that the Examiner made no mention whatsoever that *Huang*'s system has this capability in the Non-Final Action, which is now being asserted for the first time in the Final Action as a new ground. The Examiner offers no support for his conclusion that *Huang*'s system is capable of performing the recited allocation and actual does so. Thus, rather than maintaining previous grounds for rejection, the Examiner now applies a different ground of rejection.

The change in the grounds of rejection relied-upon in the Final Action was not necessitated in any way by an amendment or an IDS presented by Petitioner, but is instead presented in response to Petitioner's successful traversal of the Examiner's initial grounds of rejection presented in the Non-Final Action. Thus, the Final Action was improperly made final. Further, Petitioner has not been afforded a full and fair opportunity to consider and respond to the new grounds of rejection or the Examiner's personal knowledge because the new grounds were explained for the first time in the Final Action. Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

II. Improper Response to Petitioner's Arguments

Moreover, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." M.P.E.P. § 707.07(f). In addition to adding new grounds of rejection, the Examiner repeated the rejections of all of the claims. The Examiner, however, neither "took note" of Petitioner's argument nor "answered the substance" of Petitioner's arguments. For instance, Petitioner set forth specific arguments traversing the rejection for claims 6, 8, and 15. The Examiner did not address the arguments distinguishing claim 6 at all and merely stated that the "arguments with regards to claims 8 and 15 are not persuasive as the combinations of the applied references disclose the limitations." *See* Final Action, page 5. At the very least, the Examiner did not answer the substance of Petitioner's arguments with respect to these claims. Thus, the Final

Action is deficient because the Examiner failed to satisfy the requirements of M.P.E.P. § 707.07(f). Accordingly, Petitioner respectfully petitions the Director to vacate the finality of the Final Action for this further reason.

III. The Improper Finality Harms the Patent Owner

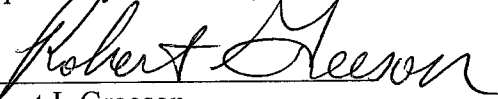
Because the above-identified new grounds of rejection were made final, Petitioner has not been afforded a full and fair opportunity to consider and address those rejections. For instance, the procedures available to Petitioner for responding after a Final Office Action are much more restrictive than are available responsive to a non-final Office Action. Accordingly, while Petitioner maintains that the new grounds of rejection are improper, Petitioner further contends that those new grounds of rejection should not have been made final to afford Petitioner a full and fair opportunity to develop and address the issues raised by the Examiner.

ACTION REQUESTED

For the reasons discussed above, the finality of the Final Action is improper, and thus Petitioner respectfully requests that the finality be vacated. Because Petitioner believes that the facts presented herein support vacating the finality of the Final Action, it is believed that no fees are due in connection with this petition; however should the Director determine that any fees under 37 C.F.R. §§ 1.16 – 1.21, including any petition fees, are required for any reason, the Director is hereby authorized to deduct said fees from our Deposit Account No. 06-2380, under Order No. 68144/P020US.B/10505125 from which the undersigned is authorized to draw.

Dated: April 13, 2009

Respectfully submitted,

By 

Robert L. Greeson

Registration No.: 52,966

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-7430

(214) 855-8200 (Fax)

Attorney for Petitioner